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GP2503

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Frank Bryant et al.

Examiner: N. Ngo

08/712,808

Art Unit: 2503

Filed: September 12, 1996

Docket No. 96-C-126

For: Method of Making Transistor Devices in an SRAM Cell

Assistant Commissioner for Patents

RECEIVED

Washington, D.C. 20231

SEP 22 1997

GROUP 2503

CERTIFICATE OF MAILING

37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, D. C. 20231, on Sept 5, 1997

Uthim Slawon

Signature

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

Please change the attorney docket number on the above-reference case from "93-C-20C1" to --96-C-126--.

In response to the restriction requirement mailed August 18, 1997, Applicant provisionally elects the claims of Group I, Claims 1-54 and 13-19, for further prosecution. The restriction requirement is respectfully traversed, on the grounds that the Examiner has not shown the reason why this restriction requirement is justified by the statutory provision that:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the applications to be restricted to one of the inventions. 35 USC 121 (emphasis added).

Thus the requirements of the statute are clear: restriction is proper only when the claims are independent AND distinct.

The Office Action does not state any reason why these claims are independent.

The term "independent" . . . means not dependent. A large number of subjects between which, prior to the 1952 Act, division had been proper, are dependent subjects, such, for example, as combinations and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc.

MPEP § 802.1

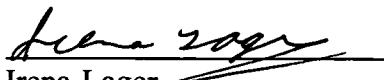
The § 802.1 of the MPEP also states that a division is proper if the inventions "are, in fact, 'distinct' inventions, even though dependent." MPEP § 802.1. This is not the same legal test, and encourages many restrictions which are not justified by the statute. The statute requires that the inventions must be independent and distinct for a restriction and there is no justification (outside of the MPEP) for division of dependent inventions. It is respectfully submitted that the plain words of the statute must control.

It is further noted that, in this case, a common search can and should be performed for all of the stated groups of claims. It is therefore respectfully submitted that there is no reason why all groups of claims could not be examined by a single Examiner.

Please charge any fees necessary for prosecution of the present application to deposit account No. 19-1353.

A first Office Action on the merits is now respectfully awaited. The Examiner is cordially invited to telephone the undersigned attorney if he or she believes that an interview might be useful for any reason.

Respectfully submitted,


Irena Lager
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